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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,934	11/04/2003	Yukihiro Shibata	501.43163X00	3889
20457	7590	11/07/2006	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			TON, TRI T	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/699,934	Applicant(s) SHIBATA ET AL.	
	Examiner Tri T. Ton	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7 and 14-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-20 is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7 and 10-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This is a response to the amendment and remarks/arguments filed on 09/25/2006.
2. Claims 5, 8-9 and 13 have been cancelled.
3. Claims 1-4, 6-7, 10-12 and 14-20 are pending.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-4, 6-7, 10-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1, 6, 10 a method of inspecting for defects, does not produce any tangible results. The practical application of the claimed invention cannot be realized until the information determined is conveyed to the user. For the result to be tangible, it would need to output to a user, displayed to a user, stored for later use, or used in any tangible manner. Illuminating, applying, composing, obtaining, detecting, imaging and inspecting would not appear to be sufficient to constitute a tangible result, since the outcome of the method has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized.

Part b. Practical Application the Produces a Useful, Concrete, and Tangible Result under Section IV Determine Whether the Claimed Invention Complies with the Subject

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Matter Eligibility Requirement of 35 U.S.C. Sec. 101, sentence 3, in the OG Notice from 22 November 2005 states ‘In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible, and concrete.”’

Hence, the claims are treated as nonstatutory functional descriptive material. See OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", MPEP Sec. 2106 and <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>).

Allowable Subject Matter

6. Claims 14-20 are allowed.
7. Claims 1-4, 6-7 and 10-12 would be allowable if the reject under 101 were overcome.
8. The following is a statement of reasons for the indication of allowable subject matter: No prior art found by the examiner that suggested modification or combination with the cited art so as to satisfy the combination of all the limitations in claims 1, 6 and 10.
8. As to claim 1, the prior art of record taken along or in combination, fails to disclose or render obvious “... composing the applied of said divided four beams that have been reflected off said sample and passed through said objective lens into a composed beam of light ...” in combination with the rest of the limitations of claim 1.

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9. As to claim 6, the prior art of record taken along or in combination, fails to disclose or render obvious “... four polarized beams, through an objective lens, whose directions of electric field vectors are aligned... with a composed beam of light which is composed with lights reflected from said substrate by the illuminating and entered said objective lens during the illumination...” in combination with the rest of the limitations of claim 6.

10. As to claim 10, the prior art of record taken along or in combination, fails to disclose or render obvious “... four beams of light of the bright-field illumination reflected from said substrate are composed into a composed beam of light used for the imaging.” in combination with the rest of the limitations of claim 10.

11. As to claim 15, the prior art of record taken along or in combination, fails to disclose or render obvious “... image forming means has a second polarization adjusting part adjusting the polarization direction of the beam made by composing each reflected light of said four beams from said substrate.” in combination with the rest of the limitations of claim 10.

12. As to claim 16, the prior art of record taken along or in combination, fails to disclose or render obvious “... the other one of the beams of light branched by the branching means is allowed to enter an oblique illuminating means illuminating said substrate obliquely.” in combination with the rest of the limitations of claim 16.

13. As to claim 17, the prior art of record taken along or in combination, fails to disclose or render obvious “... a dark-field illuminating means illuminating said substrate obliquely from outside of said objective lens with the other one of the beams of

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light branched by said branching means..." in combination with the rest of the limitations of claim 17.

Fax/Telephone Information

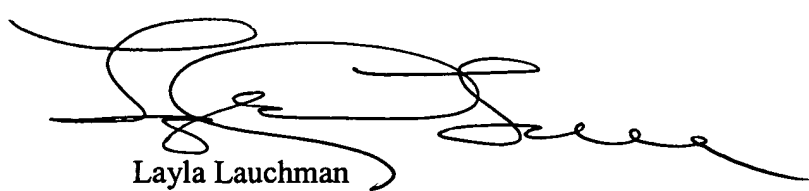
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri T. Ton whose telephone number is (571) 272-9064. The examiner can normally be reached on 10:30am - 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



October 27, 2006
Examiner Tri Ton/SN



Layla Lauchman
Primary Patent Examiner
Art Unit 2877
Technology Center 2800